

REMARKS

Applicant has carefully reviewed and considered the Final Office Action mailed on December 21, 2006, and the references cited therewith. This first reply is being filed within two months of the mailing date of the Final Office Action.

Claim 22 is amended to place it in independent form. New claims 38-42 are added to more fully describe the claimed invention. The new claims 38-42 are supported by claims 12, 20, 26, 33, and 37, respectively, and in the specification as filed on page 23 lines 15-16. No new matter is added. Applicant believes it is proper to add these claims at this time since the Final Office Action dated December 21, 2006 should not have been final, as explained below. As a result, claims 10-16 and 18-42 are now pending in the present application. The total number of claims has increased by 5, with total number of independent claims increasing by one. Please charge the small-entity fees for any additional claim fees or other required fees, or credit overpayment to Deposit Account number 19-0743.

Applicant's response to Examiners response to Applicant's Arguments

The Final Office Action dated December 21, 2006, and Non-Final Office Action, dated June 13, 2006, did not provide a basis for rejection of claims 19-22. Accordingly Applicant respectfully requests that the finality of the December 21 Office Action be withdrawn and a full response to applicants previous two submission be provided.

In the response to the Examiner's Non-Final Office Action, dated June 13, 2006, the Applicant filed a response on September 13, 2006. The Examiner essentially reiterated the June 13, 2006, Non-Final Office Action in the Final Office Action dated December 21, 2006; even so far as duplicating in section 5, "Applicant's arguments file on April 04, 2006 have been fully considered but they are not responsive", apparently not considering the response filed on September 13, 2006. The Applicant respectfully requests that this response to the Final Office action be fully considered.

The Examiner indicated in the Non-Final Office Action, mailed December 30, 2005, that claim 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. No basis for rejection has been asserted by the examiner for claim 22 in either the Non-Final Office Action dated June 13, 2006, or the Final Office Action dated December 21, 2006. Accordingly, Applicant has amended claim 22 into

independent form including all of the limitations of the base claim and any intervening claims. Reconsideration and allowance of claim 22 is respectfully requested.

The Examiner asserts that Anderson et al. (U.S. Patent Application Publication No. 2004/0158524, hereinafter “Anderson”) teaches receiving transactions from the consumer. Applicant respectfully submits that this is false. Applicant points out that Anderson states only in the background section [0004] that “following review of the transactions, a customer *may wish* to submit a payment electronically” and “The present invention (ConductorSM) is a suite of online financial services. Supported functions include credit card account lookup and reporting, and checking and bill paying.”

(The Examiner asserts that Anderson teaches a docketing provider and/or docketing functions. Applicant respectfully submits that this is false. There is nothing in Anderson and no suggestion from either reference about docketing as used and well known in the patent application field.)

There is no indication that the described invention of Anderson would or could accept a transaction from a customer and no enabling disclosure. Anderson only says “a customer *may wish* to” (emphasis added) – **not that their system does this**. Anderson in paragraph [0033] says “Preferably, users may view and manipulate only their own financial data. Furthermore, users may not alter the data. Preferably, users have the option of downloading the financial data to an accounting software package.” This is not an indication that Anderson’s system receives transactions from the consumer, nor does it indicate the data can be manipulated on Anderson’s system. Rather, Anderson indicates that the consumer downloads the credit-card financial data directly to an accounting or word-processing program for further processing (Abstract and [0034]). This manipulation or further processing thus occurs in a different program on the consumer’s own computer.

The Examiner asserts that transactions in Anderson include financial transactions and reports for a user’s current month’s statement received in electronic mail. Applicant respectfully submits that this is false. Anderson does not describe or suggest electronic mail or messages. Anderson [0032] says “The present invention allows users to receive this information in a more timely manner as it is available before a statement arrives in the mail.” Mail is not email, it is the

postal service. Further, why would a consumer “more timely” receive the data via a browser if it arrives in an *email*? They would not.

The Examiner asserts that Anderson teaches accepting transactions for adding or manipulating data in the database. Applicant respectfully submits that this is false. Anderson does not describe or suggest accepting transactions from the consumer for adding or manipulating data in the database. It is impermissible for the Examiner to use the teaching of the present invention to supply gaps and fill in missing limitations by inferring that Anderson teaches something not taught or suggested. Anderson describes the consumer downloading their data into Quicken or WordPerfect for further processing, and specifically teaches away from allowing the consumer to alter their data, saying: “**Furthermore, users may not alter the data.**” (Anderson [0033], emphasis added).

The Examiner asserts that it is merely a matter of design choice to modify Anderson for accepting patent application transactions for adding or manipulating data in the database. Applicant respectfully submits that this is false. Anderson is a credit-card/financial transaction monitoring system. There is no teaching or suggestion to modify that system to provide patent-application transactions. The Whitmyer reference describes only transferring intellectual property, nothing about the patent application itself or its prosecution.

The Examiner asserts that Whitmyer inherently teaches an attorney for the inventor in order to handle legal matters with the proper preparation and prosecution of the patent transactions. Applicant respectfully submits that this is false. Anderson does not describe or suggest preparation and prosecution of patents, nor use the words “attorney,” “preparation,” or “prosecution.” It is impermissible for the Examiner to use the teaching of the present invention to supply gaps and fill in missing limitations by inferring that Whitmyer teaches something not taught or suggested.

The Examiner promised to provide the parent and provisional application for Whitmyer, but has not as yet provided that information. It is patently unfair for the Examiner to “believe” the priority documents support any of her assertions without providing proof that such applications contain any relevant information. Applicant has downloaded U.S. Provisional Application No. 60/143,092 (the Whitmyer provisional), which lacks teaching, enablement, and written description for the arguments proposed by the Examiner (there is no detailed description

of what, if anything, the Figures represent). Applicant respectfully requests copies of any documents used for the Examiner's rejections.

Argument

Rejection Under 35 U.S.C. § 102(e)

1) The Applicable Law for Rejections Under 35 U.S.C. § 102(e)

The Applicable law was provided in the Applicant's Amendment and Response filed 21 July 2005 and is not repeated here. Please refer to the remarks in that 21 July 2005 response.

2) The 35 U.S.C. § 102(e) Rejections

Claims 10-15 and 30-34 were rejected under 35 U.S.C. § 102(e) for anticipation by Anderson et al. (U.S. Patent Application Publication No. 2004/0158524). Applicants respectfully traverse the rejection. Anderson describes a system wherein a customer accesses a web page of a financial services provider using the customer's computer and browser, is connected to a database that allows the user to download credit card or debit card transactions (see paragraph [0033]). There is no description or suggestion that the system would or could receive "a second transaction from a service consumer," but rather the reference says "Furthermore, users may not alter the data."

Analysis

Anderson fails to anticipate the present claims, since it does not contain each and every element as set forth in the claim, either expressly or inherently described (*See Verdegaal, supra*). Anderson fails to teach or suggest receiving or storing both the second transaction by the service consumer (Anderson's "user") and the first transaction by the service provider (Anderson's "financial services provider" or "Conductor host") into the database, wherein access to the transactions is selectively enabled to the service consumer/customer based on an identification of the service consumer, and wherein the transactions are then accessed by the service consumer/customer. The Office Action mailed April 19, 2005, points to paragraphs [0026] and [0033], neither of which show a plurality of transactions for a database including one from a service consumer and one from a service provider.

Although Anderson uses the word “transaction,” the meaning of that word as used by Anderson is of a credit or debit card transaction (see paragraph [0027]) and is not the same as “transaction” as used in the present application (i.e., in the present invention, the transactions are computer-actionable data that add to or modify information in a database).

Further, as far as Applicant can determine, Anderson does not receive any transactions from a service consumer, and in fact in paragraph [0033] says

“Preferably, users may view and manipulate only their own financial data. Furthermore, **users may not alter the data**. Preferably, users have the option of downloading the financial data to an accounting software package such as Intuit's Quicken, or a word-processing program such as Novell's WordPerfect.” (emphasis added)

In contrast, the invention recited in claim 10 of the present application provides “**selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled.**” (emphasis added) The Examiner points to paragraph [0033] and the abstract of Anderson. Applicant can find no teaching or suggestion in these sections of Anderson cited by the Examiner that enable the customer, based on identification of the customer, to access those defined transactions in the database system (as recited in claim 10 and claim 14).

In contrast, the present invention as recited in claims 10 and 14 provides a method (or media having the method) comprising:

receiving a plurality of **transactions for the database system** including a **first transaction from a service provider** and a **second transaction from a service consumer**, wherein the first and the second transactions are each associated with the service consumer;

storing the plurality of transactions into the database system; and

selectively enabling access by the service consumer, based on an identification of the service consumer, to the stored first and second transactions associated with the service consumer to whom access is enabled. (emphasis added)

(emphasis added)

The recited combination of transactions and the selective enabling of accesses to the database distinguish the present invention from Anderson. Accordingly, reconsideration and allowance of these claims and their dependent claims is respectfully requested.

As to dependent claims 11, 15, and 32 (also applies to 19, 25, and 36) Anderson describes nothing about any **docketing** function or provider. The Office Action has failed to provide a *prima facie* case of anticipation. The claimed combination where the method further includes "receiving transactions by a docketing provider" is clearly distinguished. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 12 and 33, Anderson describes nothing of pending action items, but rather is a record of past credit-card transactions on a daily basis. In contrast, this feature of the present invention is useful for such professions as law and others. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to dependent 30 (also applies to claims 22, 28), Anderson does not describe email or electronic message, and no decoding of a transaction from an electronic message. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to dependent 31 (also applies to claims 23, 29), Anderson does not describe email or electronic message, and no encoding of a transaction from an electronic message. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to the remaining claims not separately discussed above, each is dependent on a claim that appears allowable, as discussed above. Further, each describes further limitations that form a combination with the respective parent claim, and these combinations are also not described in the cited reference. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Applicant respectfully request reconsideration of the rejections of claims 10-15 and 30-34.

Claim Rejections – USC § 103

Claims 16, 18-29 and 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. (U.S. Patent Application Publication No. 2004/0158524, hereinafter "Anderson") in view of Whitmyer, Jr. (U.S. Patent Application Publication No. 2002/0029215, hereinafter "Whitmyer"). Applicants respectfully traverse the rejection.

The Examiner asserts she believes Whitmyer is qualified as a prior art since its (parent's) provisional application, filed on July 9, 1999, is earlier than Applicant's application filed

September 11, 2000 (see Non-Final Office Action mailed June 13, 2006, bottom of section 4 on page 8). Applicant respectfully disagrees. Attached to this Amendment and Response is a copy of the Whitmyer U.S. Provisional Application No. 60/143,092 (hereinafter “Whitmyer Provisional”). The Whitmyer Provisional does not qualify as prior art since it does not provide enablement or written description of the features relied upon by the Examiner. Whitmyer Provisional provides two terse drawings without an enabling or written description. There is nothing to indicate what, if anything, the box “IP Office” or the arrow to it mean. The entire “Detailed Description of the Invention” consists of:

“It is to be understood that, although specific embodiments of the invention have been described herein in detail, such description is for the purposes of illustration only and modifications may be made thereto by those skilled in the art within the scope of the invention.”

This non-enabling written description cannot qualify the Whitmyer Provisional as prior art. Further, no copy of the supposed July 7, 2000 application or its contents are available to Applicant and it has not been provided by the Examiner, and the filing date for the cited November 29, 2000 Whitmyer non-provisional is too late to qualify as prior art.

As to claim 16, this claim is dependent on claim 14, but further recites that “the transaction is associated with a patent application service matter.” In contrast, Whitmyer describes a system facilitating transfer of IP property, and nothing for a patent application service matter. The present invention, on the other hand, is useful for such professions as patent-law prosecution and others. Reconsideration and allowance of this claim is respectfully requested.

Further, regarding claim 18 and its dependent claims, the Examiner has failed to provide a 35 U.S.C. § 112 paragraph 6 means-plus-function analysis to show the prior art combination to be the structure and acts described in the present invention or equivalents thereof. Accordingly, her analysis fails to support the 103 rejection.

As to claim 18, this claim and its dependent claims are means-plus-function claims, and must be examined under 35 U.S.C. § 112 paragraph 6, to be the structure and acts described in

the present invention and equivalents thereof. The Office Action has failed to provide a reference with the required equivalents as analyzed under 35 U.S.C. § 112 paragraph 6. Accordingly, reconsideration and allowance of these claims is respectfully requested. The Anderson reference does not describe nor suggest transactions that “are each transactions that add information regarding a patent application to the database.” Accordingly, reconsideration and withdrawal of this rejection is respectfully requested, and an early notification of allowance be provided.

As to claims 19-22, the Examiner has failed to provide any showing of unpatentability at all, other than saying the claims are rejected. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Further as to dependent claims 19, 25, and 36, neither Anderson nor Whitmyer describe anything about any **docketing** function or provider. The Office Action has failed to provide a *prima facie* case of obviousness. The claimed combination where the method further includes “receiving transactions by a docketing provider” clearly distinguishes over the cited references. Accordingly, reconsideration and allowance of these claims is respectfully requested.

As to claims 23 and 29, Anderson does not describe an input device for a database transaction, but rather a generic input device. The Examiner asserts that it is inherent. Applicant cannot find any indication that this input device is used for entering a database transaction in Anderson. The Examiner asserts 90-94 insert a transaction into an electronic message. Applicant respectfully submits that this is false. First, there is no email or electronic message mentioned anywhere in Anderson. Second, Figure 4 is described as “Referring to FIG. 4, a diagrammatic representation of an individual financial transaction is shown. Preferably, for each credit or debit card transaction, the data for each record includes” [the data shown in Figure 4 and described in paragraph [0027]]. There is no electronic message anywhere taught or suggested. It is improper for the Examiner to use the teaching of the present invention to supply gaps and fill in missing limitations by inferring that Anderson teaches something not taught or suggested. Accordingly, reconsideration and allowance of these claims is respectfully requested.

Further, it is well settled that the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir 1990). If the proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir 1984).

In the present case, there is absolutely no suggestion in the prior art to modify the Anderson database of credit-card and checking records to accept intellectual property transactions. Applicant submits that changing a financial database of credit card transactions to receive "a plurality of transactions for the database system including a first transaction from a service provider associated with an intellectual property law lawyer and a second transaction from a service consumer, wherein the first and the second transactions are each associated with the service consumer and are each transactions that add information regarding a patent application to the database" would render the Anderson database unsuitable for its original purpose. Accordingly, reconsideration and withdrawal of the rejection and an early indication of the allowability of these claims is respectfully requested.

It is respectfully submitted that the cited art neither anticipates nor renders the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 10-16, 18-37 should be allowed in view of the arguments presented. Reconsideration and withdrawal of the Examiner's rejections of claims 10-16 and 18-37 is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (952-278-3501) to facilitate prosecution of this application.

If not otherwise provided herewith, please consider this a request for an extension of time for a sufficient number of months to enter these papers. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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